

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
Muller-6-1

In Re Application Of: **Andrea Brasch; Klaus Diblitz; Arnold Meyer**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/054,830	01/23/2002	Christina A. Ildebrando	000039703	1725	9096

Title: **Process for the Manufacture of Dispersible Alumino-Silicates**

COMMISSIONER FOR PATENTS:

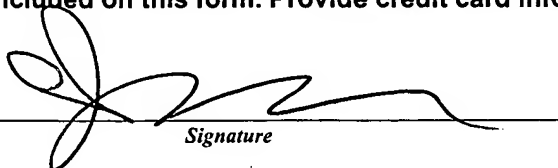
Transmitted herewith is:

Response to Office Action , Petition Pursuant to Rule 1.1(a)(3)(c) , Acknowledgment Postcard

in the above identified application.

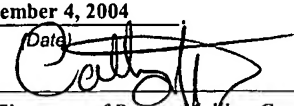
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Signature

Dated: **November 4, 2004**

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Cathy Hayes	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	Attorney Docket No.:	Muller-6-1
Andrea Brasch; Klaus Diblitz;	§		
Arnold Meyer	§		
	§	Parent Serial No.:	09/269,989
Serial No.: 10/054,830	§	Anticipated Art Unit No.:	1725
	§		
Filing Date: 01/23/2002	§	Parent Filed:	May 1, 2000
	§		
For: <i>Process for the Manufacture</i>	§	Confirmation No. 9096	
<i>of Dispersible Alumino-Silicates</i>	§		
	§	Examiner: Christina A. Ildebrando	

PETITION PURSUANT TO RULE 1.1(a)(3)(c)

Mail Box: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition the Director to reverse the Examiner's decision denying the claim of priority and to take such action and issue such papers as are necessary to acknowledge and grant Applicants' claim to priority. It is to be noted that in the final rejection in the captioned application which issued on May 7, 2003, the Examiner denied Applicants' claim for priority under 35 U.S.C. 119(a)-(d). In the subsequent Notice of Allowance and Fee(s) Due issued January 30, 2004 in the Notice of Allowability accompanying that document, the denial of priority was repeated. Subsequent to the Notice of Allowance and Issue Fee(s) Due, Applicant filed a Petition to withdraw the application from issue so that Applicant could file a petition requesting that Applicants' claims for priority be acknowledged and granted. The Petition to Withdraw from Issue was granted on May 7, 2004, the application being forwarded to the Examiner. On

August 4, 2004, the Examiner issued a non-final action again denying Applicants' claim to priority and rejecting all claims under 35 U.S.C. §102(b) as being clearly anticipated by DE 196 41 142, the German counterpart of the captioned application. For reasons set forth hereafter, it is respectfully submitted that the Examiner's denial of the claim of priority is in error and should be reversed.

1. On April 5, 1999, a §371 application was filed in the U.S. Patent and Trademark Office and was assigned Serial No. 09/269,989 ('989 Application). On the same day, a second §371 application Serial No. 09/269,992 ('992 Application) was also filed.
2. Unfortunately, the English translations of the corresponding PCT applications of the '989 and '992 Applications were mixed up, i.e., the English translation of the PCT Application upon which the '989 Application was based was filed in connection with the filing which matured into the '992 Application and vice-versa.
3. In the case of the '992 Application, the error was immediately caught by the Patent Office and Applicant in that case was required to file a correct translation which was done. The '992 Application has now matured into U.S. Patent No. 6,245,310.
4. In the case of the '989 Application, on July 28, 2000 a Notice of Acceptance under §371 was received.
5. Subsequently in a decision issued January 31, 2000, the Notification of Acceptance was vacated on the basis that the translation which had been filed was not an acceptable English translation of the International

Application as required under 35 U.S.C. §371(c)(2). Responsive to this decision, Applicant filed the correct translation together with claims which were supported by the correct translation, such filing being effective May 1, 2000.

6. Again unfortunately, with the filing referred to in Paragraph 5 Applicant filed a Preliminary Amendment with Claims 22-37 that were not supported by the translation and in fact were claims supported by the specification of the '992 Application.
7. In any event, on July 13, 2000, the Office mailed a Communication Re: Notification of Abandonment which vacated a Notice of Abandonment issued by the Office on May 9, 2000 and which acknowledged Applicants' claim for priority and assigned an international filing date of 27 December 1997 under §363 and a date of 01 May 2000 under 35 U.S.C. §371(c) and 102(e).
8. On October 5, 2000, after a teleconference with the Examiner, a Supplemental Preliminary Amendment was filed with Claims 38-53 which replaced Claims 19-36 which had been filed in connection with the Preliminary Amendment noted in Paragraph 6.
9. Setting aside a numbering problem of the claims, the Preliminary Amendment noted in Paragraph 6, and the Supplemental Preliminary Amendment noted in Paragraph 8 had one thing in common - they were not supported by the proper translation which had been filed with the filing set forth in Paragraph 5 and accordingly would have been subject to

rejection under §112.

10. Apparently unbeknownst to the Examiner that the claims submitted with the Supplemental Preliminary Amendment noted in Paragraph 8, were still the wrong claims, on February 2, 2001, the Examiner issued an Office Action on the merits. At this point, Applicant realized that the claims which had been treated on the merits by the Examiner were the incorrect claims. Accordingly, Applicant called the Examiner and pointed out the error.
11. Subsequently, Applicant filed an Amendment on June 7, 2001 which now contained Claims 53-70 which were supported by the correct translation and indeed were essentially the same claims filed in connection with the filing noted in Paragraph 5.
12. On September 15, 2001, Applicant received a communication from the Office (Paper No. 21) in which the Supervisory Patent Examiner advised Applicant that the newly submitted claims 53-7 which had been submitted with the Amendment noted in Paragraph 11 were directed to an invention that is independent or distinct from the invention originally claimed. In effect, the paper held that the Amendment filed on June 7, 2001 was non-responsive. However, it was also stated that the Amendment appeared to be a bona fide attempt to reply and, accordingly, Applicant was given a time period of one month or 30 days, subject to extensions, to correct the error. In point of fact Applicant submits that there really was no error since the claims filed with the filing noted in Paragraph 11 were in fact the correct claims and were in fact supported by the correct translation noted

in Paragraph 5.

13. In any event, Applicant then called the Examiner to discuss the best and most expeditious way to handle this matter. The Examiner informed Applicant that the best course of action would be to file a continuation which was filed on January 23, 2002, the continuation specifically referring to the '989 Application. The continuation application was assigned Serial No. 10/054,830 (the '830 Application) which is the captioned application.
14. In connection with the filing of the '830 Application, Applicant submitted a Preliminary Amendment which contained the same claims which had been filed with the amendment of June 7, 2001 noted in Paragraph 11, i.e., the claims in the Preliminary Amendment were the correct claims in that they were supported by the disclosure of the correct translation filed with the filings noted in Paragraph 5.
15. Applicant then received an action on the merits, the action being mailed on May 7, 2003, and in that action the Examiner denied Applicants' claim for priority based on German application May 10, 1996 upon which the original PCT application had been based.
16. On January 7, 2003, Applicant filed a response to the Office Action noted in Paragraph 15 and basically laid out the facts set out above, Applicants' position being that although improper claims were submitted in a Preliminary Amendment with the filing noted in Paragraph 5, that filing did in fact contain the proper translation. It was also pointed out to the Examiner that Claims 22-41 which had been filed with the '830 Application

basically incorporated the subject matter of Claims 1-21 of the '989 Application and in any event were unequivocally supported by the disclosure of the '989 Application, the parent of the captioned application ('830 Application).

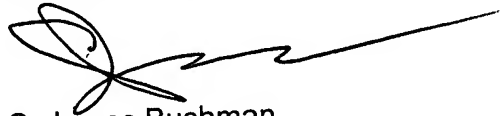
17. It was Applicants' position that priority should not be denied since the disclosure of the '830 Application was identical with the correct translation which had been filed with the filing noted in Paragraph 5.
18. Subsequently on January 30, 2004, the Examiner issued a Notice of Allowance and Fee(s) due with a Notice of Allowability and in the Notice of Allowability again denied Applicants' claim for priority which prompted a Petition to Withdraw from Issue to allow Applicants to resolve the priority issue.
19. While Applicant would admit that at all times when the incorrect claims were before the Office, the Examiner could have issued a §112 rejection. The fact of the matter is that since the filing mentioned in Paragraph 5, the Office has had before it the correct disclosure, i.e., the disclosure of the '989 Application is identical to the disclosure of the captioned application ('830 Application).
20. While Applicant admits to the error in filing the improper claims as outlined above, i.e., claims that were not supported by the disclosure of the '989 Application, it is also significant that in the Office Action noted in Paragraph 10, the Examiner did not issue a §112 rejection but rather treated those claims on the merits. The point is not to blame the

Examiner for failure to issue a §112 rejection since the Examiner has been most helpful in attempting to resolve this matter. However, had the Examiner issued a §112 rejection, Applicant would have immediately filed the proper claims and in point of fact although the Examiner did not issue a §112 rejection, Applicant did attempt to file the proper claims with the amendment noted in the filings mentioned in Paragraph 11.

21. Since the filing of the correct translation of the '989 Application on May 1, 2000, as noted in Paragraph 5, the correct disclosure has been in front of the Patent Office albeit that until the Amendment noted in Paragraph 11, incorrect claims were in front of the Patent Office. However, it is respectfully submitted that the Examiner's statement in the Notice of Allowability that the disclosure of the '989 Application does not contain support for the claim language or does not support the subject matter of the '830 Application is simply an error. As the Examiner points out in the Notice of Allowability, the claims filed with the response of June 7, 2001 noted in Paragraph 11, had they been treated on the merits would have been subject to a rejection under 35 U.S.C. §112. Applicant takes no issue with that but that position does not support the Examiner's position that the claim of priority should be denied.

22. In view of the foregoing, it is respectfully requested that the Director vacate the Examiner's decision that Applicants claim to priority is improper and that Applicant be granted priority.

Respectfully submitted,



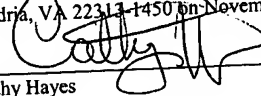
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Date: November 4, 2004

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By: 
Cathy Hayes

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